

## REMARKS

In an Office Action mailed on January 17, 2006, claims 25 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson in view of Current; claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson in view of Current and further in view of Cook; and claim 31 was allowed. The § 103 rejections are addressed below.

### § 103 Rejections of Claims 25-27:

As amended, the seal element of independent claim 25 includes a support sleeve and a sealing layer that at least partially encloses the support sleeve.

Contrary to the limitations of claim 25, Simpson discloses strips of metal that are provided between a slotted tubing 84 and a sleeve 86. Simpson, paragraph no. 49. Thus, as conceded by the Examiner, Simpson fails to teach or suggest the support sleeve of claim 25.

The Examiner modifies Simpson in view of Current to allegedly derive the claimed invention. In this regard, the Examiner contends that it would have been obvious for one skilled in the art in view of the teaching of Current to modify Simpson's metal strips to replace these strips with an anti-extrusion sleeve of Current. Office Action, 2. However, the Examiner fails to establish a *prima facie* case of obviousness for at least the reason that the Examiner fails to show where the prior art contains the alleged suggestion or motivation for this modification.

More specifically, the anti-extrusion sleeve 177 of Current is located on the *outside* of the packer's sealing element for purposes of limiting the longitudinal extrusion of the sealing element when the packer is set. The sleeve 177 is not, however, located on the *inside* of the seal element. As a result, Current fails to contain a suggestion or motivation to modify Simpson's metal strips so that the metal strips form an anti-extrusion sleeve, as such a sleeve would not function as intended on the inside of Simpson's seal element. Thus, in summary, neither Simpson nor Current contains a suggestion or motivation to convert Simpson's metal rings into a sleeve, and for at least this reason, a *prima facie* case of obviousness has not been established for claim 25. Claims 26 and 27, and newly-added claim 32 are patentable for at least the reason that these claims depend from an allowable claim.

Newly-added Claims 33-36:

The method of newly-added independent claim 36 includes providing a packer that includes a support sleeve, a sealing layer that at least partially encloses the support sleeve and a tube that includes slots.

See discussion of independent claim 25 above. In particular, for at least the reasons that the hypothetical combination of Simpson and Current fails to teach or suggest the relationship of a support sleeve and the sealing layer, allowance of claim 33 is requested.

Claims 34-36 are patentable for at least the reason that these claims depend from an allowable claim.

Newly-Added Claims 37-39:

The seal element of independent claim 37 includes a moveable element that is adapted to radially extend inside a bow to contact the inner surface of the bow to cause the bow to radially extend outwardly against the support sleeve such that the outer surface of the bow presses the sealing layer against a wall that encloses a packer to form a sealing contact between the sealing layer and the wall.

For at least the reason that the cited art fails to teach or suggest a moveable element that is adapted to extend radially inside a bow to contact an inner surface of the bow to radially extend the bow, the prior art fails to teach or suggest the limitations of newly-added independent claim 37.

Claims 38 and 39 are patentable for at least the reason that these claims depend from an allowable claim.

Newly-Added Claims 40-42:

The method of newly-added independent claim 40 includes moving a moveable member radially inside a bow to contact an inner surface of the bow to cause the bow to radially extend outwardly. For at least the reason that the prior art fails to teach or suggest these limitations, allowance of newly-added independent claim 40 is requested.

Claims 41 and 42 are patentable for at least the reason that these claims depend from an allowable claim.

Newly-Added Claims 43-48:

The seal element of newly-added independent claim 43 includes a mechanism that is adapted to hold an energizing element in a first position prior to a packer being run into a well to store potential energy and release the energizing element downhole in the well to release at least some of the potential energy at a predetermined position to radially expand the energizing element and establish contact between the sealing element and a wall that encloses the packer.

As previously pointed out, none of the cited art teaches or suggests storing potential energy prior to a packer being deployed downhole such that the potential energy is released downhole to cause radial expansion of a seal element. Thus, none of the previously-cited art teaches or suggests the mechanism now set forth in newly-added independent claim 43. As such, allowance of newly-added claims 43-48 is requested.

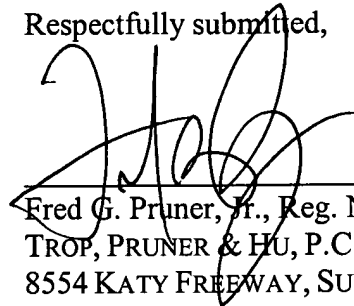
Newly-Added Claims 49 and 50:

Previous claim 18 has been rewritten as newly-added independent claim 49. For at least the reasons set forth in the Reply to Final Office Action dated September 22, 2005, Applicant respectfully requests reconsideration of the patentability of this claim. More specifically, none of the prior art teaches or suggests storing prior energy in a seal element of a packer before deploying the packer in the well and setting the packer by releasing at least some of the potential energy. Thus, Applicant requests allowance of claims 49 and 50.

CONCLUSION

In view of the foregoing, withdrawal of the remaining § 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0268US).

Respectfully submitted,



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